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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,734	06/21/2001	Stephen L. Fichera	SYP-166	6037

7590 03/29/2004
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EXAMINER

CROSS, LATOYA I

ART UNIT PAPER NUMBER

1743

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,734

Applicant(s)

FICHERA ET AL.

Examiner

LaToya I. Cross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2001.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 2, 4 and 6-14 is/are rejected.
7) ☒ Claim(s) 3 and 5 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 06 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4,219,529 to Tersteeg et al.

Tersteeg et al teach a device for chemical analysis. The device comprises a slide element (44), a metering device (26) an incubator (30), an analysis unit (32) and a disposal unit (60). The slide moves from the metering device to the incubator to the analysis unit and on to the disposal unit by way of a slide transfer mechanism. At col. 3, lines 40-52, Tersteeg et al teach that a transfer mechanism (53) moves a slide from the incubator to the analysis means and from the analysis means into the disposal chute. At col. 6, lines 44-49, the reference teaches that the slide transfer means “simultaneously” moves a first slide out of the rotor means and into the analysis mean and a second slide out of the analysis means and into a discharge chute. There exists a vertical space between the entrance into the analysis means (32) and the disposal, which is the exit point for the analysis means. With respect to claims 4 and 6, figure 1 of Tersteeg et al shows that the entry into the analysis means is located at a position above the disposal, which is the exit point for the analysis means.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be anticipated, within the meaning of 35 USC 102(b) in view of the teachings of Tersteeg et al.

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tersteeg et al in view of US Patent 5,736,102 to Seaton et al.

The disclosure of Tersteeg et al is described above. Tersteeg et al fail to teach moving one slide out of the analysis means, moving another slide into the analysis means and reversing the process.

Seaton et al teach a test sample positioning system whereby sample trays are moved across a sample testing machine. The system uses a series of drive means to allow the sample trays to move in forward and reverse directions. It would have been obvious to one of ordinary skill in the art to modify Tersteeg et al by making the slide transfer mechanism capable of moving in a reverse motion. Such would allow the sample slides to be analyzed by the analysis means and in an event, such as where the results are inconclusive, the slide can be moved back

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to the metering station and/or incubation station for further processing, thereby increasing the versatility of the system.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious, within the meaning of 35 USC 103 in view of the teachings of Tersteeg et al and Seaton et al.

6. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tersteeg et al in view of US Patent 6,111,251 to Hillenkamp.

The disclosure of Tersteeg et al is described above. Tersteeg et al fail to teach MALDI mass spectrometer as the analysis device.

Hillenkamp teaches that MALDI mass spectrometers, TOF mass spectrometers in particular, are useful in the mass determination of biopolymers and substances such as peptides, proteins and DNA fragments. Hillenkamp further teaches that in MALDI mass spectroscopy processes, large biological molecules are released from a sample and analyzed without charring, fragmentation or chemical degradation. It would have been obvious to one of ordinary skill in the art to modify Tersteeg et al by incorporating a MALDI mass spectrometer as the analysis device to allow the analysis of biomolecules, without sacrificing the integrity of the sample.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious, within the meaning of 35 USC 103 in view of the teachings of Tersteeg et al and Hillenkamp.

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Allowable Subject Matter

7. Claims 3 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to teach or suggest a slide transfer device, where one slide is moved into an analysis device concomitantly with another slide being moved out of an analysis device and wherein the entry path of the analysis device is positioned below the exit path of the analysis device.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256.

The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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March 18, 2004


Jill Warden
Supervisory Patent Examiner
Technology Center 1700